

REMARKS

In his last Office Action, the Examiner rejected Claims 7, 20 and 21 as obvious in view of a combination of Leopold et al., U.S. Patent No. 1,664,302, and Payson, U.S. Patent No. 3,983,650. Applicant respectfully traverses this ground for rejection.

Applicant attaches a set of sketches which illustrates the differences among the Payson (Fig. A), Leopold et al. (Fig. B) and MacNeil (Fig. C) structures. Each of the sketches is a longitudinal sectional detail, in a direction parallel to the structure's longest direction, and taken through a mounting hole. The MacNeil sketch is of the commercial embodiment of this invention.

In Payson, a blind hole 38 is drilled into a wooden (preferably mahogany; Col. 3, lines 20 - 21) frame element, of which frame element 18 is representative. The hole 38 is centered below a rectangular, circumferential groove 31 made in each of the frame elements 18 - 24, in which are placed or glued strips of an opaque, preferably plexiglass gasket 26 (Col. 3, lines 25 - 31). A transparent, preferably plexiglass (Col. 4, lines 21 - 22) cover 12 is placed on top of this. Holes in the gasket 26 and the cover 12 are centered on the frame hole 38 and all receive a quick-release fastener 14. Supposing *arguendo* that the blind hole 38 is taken as an equivalent to applicant's through-hole 20 (which, as claimed, goes all the way from the outside to the inside of Applicant's frame) the sidewall of Payson's hole manifestly is not completely formed of nongasket material. The gasket 26 forms a portion of the hole sidewall, between other portions of the sidewall formed by the wood frame element 18 and the cover 12.

Contrast this structure to the section of the Applicant's invention shown in Fig. C. In the Applicant's invention, a sidewall 102 of nongasket material is formed to extend all of the way to the inner surface 104, which is substantially coplanar with the generally planar receiving surface 46a of

the gasket 40. Thus, the entire sidewall of the mounting hole 20, from the very outside of the frame to the inside, is formed of a substantially noncompressible material. This creates a compression delimiter function that prevents overcompression of the gasket 40, as might happen by overtightening fastener 64, which in turn prevents the cracking of the frame 12 by this cause.

One could also view the cover 12 of Payson independently of the rest of Payson's structure. Then, it could be said that the sidewall of the cover's fastener hole was entirely formed of nongasket material. But, contrary to what Applicant's claims require, the Payson cover 12 doesn't have a gasket at all, and therefore Payson's cover has no need to limit the compression of a gasket that doesn't exist.

In the Leopold et al. structure, and unlike the claimed invention, the provided flat annular gasket 10 is positioned remotely from the mounting bolt hole 6. The Examiner states that in Leopold et al., each hole has a sidewall of nongasket material that extends from the outer side of the frame to the inner side of the frame. This is unsurprising, because Leopold's gasket 10 is nowhere near this mounting hole. Applicant's claims require, on the other hand, that the gasket material be *laterally adjacent to* and to *closely laterally surround* the hole. This relationship is evident in Applicant's Fig. C, in which the gasket 40 closely laterally surrounds a lip or boss which forms a portion of the mounting hole and sidewall and which terminates at surface 104.

The Examiner then proceeds to modify the Leopold et al. structure by forming a channel in the Leopold et al. glass frame 2, and to put the gasket 10 into it, pointing to Payson's groove 31 and gasket 26. The Examiner states that this would have been obvious, as it would permit a more secure attachment of the Leopold et al. gasket 10 to the frame 2. Applicant asserts that the indicated modification would not have been an obvious one to make, as it creates disadvantages which

outweigh the enhanced security of the gasket attachment, and is taught away from by both references. In any event, this combination still would not have resulted in either the structure or function of the invention.

First, the Payson groove 31 and gasket 26 are formed in a wood frame 18, corresponding (in the MacNeil and Leopold et al. structures) to the license plate. Neither Leopold et al.'s cover 2 nor Payson's cover 12 has a channel in it. The Payson gasket 26 isn't formed in the cover 12; it tries to seal *with* the cover 12 (Col. 4, line 10), Payson obviously and probably correctly believing that the sealing property of one plexiglass surface onto another one would be better than plexiglass-on-wood. One nonobvious mental step the skilled artisan would have to take would be to invert Payson's groove/gasket structure 31, 26 and take it out of the wood frame element 18, such that Payson's desired sealing action disappears. Payson provides no suggestion to do this. Forming a channel in Payson's plexiglass cover 12, to put a plexiglass gasket 26 into it, in fact would be pointless, and Payson's overall structure and purpose teaches away from such a modification.

Second, relative to the modified Leopold et al. structure, the Examiner does not say exactly where he would put the Payson channel. One channel location would be immediately below the gasket 10 in that gasket's original location, such that the gasket 10 remains in registry with the license plate mounting bead 9. But that disposition would not yield the claimed invention, as the gasket then would not be "laterally adjacent to" the mounting holes 6, nor "closely laterally surround" them. Also, sinking the gasket 10 into a channel at this position would reduce the ability of the gasket to seal with the license plate 4, as the whole surface of the license plate 4 would be closer to the inner surface of the cover 2. Particularly if the license plate had raised lettering, the mounting screws 5 would have a diminished or no capacity to compress peripheral bead 9 into the

gasket 10, and the ability of the gasket 10 to seal with the peripheral license plate bead 9 would be diminished or lost.

Alternatively, theoretically the Payson channel could, per the Payson design, be placed so as to intersect the Leopold et al. mounting holes. The skilled artisan would have to have found it obvious to move the Leopold et al. gasket 10, from its peripheral position at which it mates with peripheral license plate bead 9, laterally inward to a position that includes the lateral position of the mounting holes 6. There would be two negative effects of this: There would no longer be a seal to the peripheral license plate bead 9, which is one of Leopold's stated objectives (Col. 2, lines 74 – 84), and the gasket would obscure the lettering on the license plate 4. Here, then, are two independent reasons why moving the gasket to this more central position would *not* have been obvious; Leopold et al.'s overall design militates against such a modification.

Either way, and despite the good reasons why it wouldn't be made, this modification *still* doesn't result in the claimed invention. If one positions a channel to be laterally in the same place as Leopold's mounting holes, and fills that channel with gasket material, one will obtain mounting holes with sidewalls that are *not* completely made up of nongasket material. The mounting holes would look like those in Payson, in which a portion of the mounting hole sidewalls are formed by gasket material. Because the mounting hole sidewalls would be formed in part of relatively compressible gasket material, one would not have the gasket compression delimiter structure that is the principal bjective of the invention claimed herein. If Payson's channel and gasket were superimposed on Leopold et al.'s holes 6, the overtightening of Leopold et al.'s bolts 5 and nuts 8 would compress the gasket between the metal license plate 4 and the glass cover 2, and if this overtightening were taken far enough, the glass would fracture at the mounting hole.

Leopold et al. teach away from such a compression delimiter function anyway. Leopold et al. *want* the bolts 5 to press the license plate “firmly” into the gasket, compressing the general receiving surface of the gasket 10, to such an extent that the gasket 10 deforms and seals with the peripheral license plate compression bead 9. See Figs. 3 and 4 and Col. 2, Lines 79 – 81.

For the above reasons, Claim 7 is neither anticipated nor made obvious by the attempted combination of Payson and Leopold et al.

Claims 20 and 21 are patentable at least for their dependency on Claim 7. Furthermore, in regard to Claim 21, neither Payson nor Leopold et al. show or suggest a channel formed in their *covers*, which is the structure corresponding to Applicant’s frame. Further Applicant must traverse the Examiner’s statement that the method of making the gasket (injection molding) should not be given any weight in an article claim. This is because this process (injection molding) yields a product which is physically different from others. Unlike gluing or even relying on friction to hold the gasket in place (both suggested by Payson, who understandably does not describe injection molding of a hot elastomer into a wooden channel), injection-molding of a liquid thermoplastic elastomer into the channel, which liquid then solidifies, results in a gasket which has a tight molecular interface with the channel sides, providing enhanced resistance to delamination. Since injection-molding the gasket into the channel provides a technical advantage over structures in which the gasket, already in solid form, is simply glued or placed in such a channel, additional patentable weight should be accorded Claim 21.

The Examiner rejects Claims 19, 3, 4 and 8 as obvious in view of a combination of Leopold et al., Payson, and Dutt, U.S. Patent No. 4,308,965. Preliminarily, and relative to the Dutt reference, the Applicant must once again object to the Examiner’s borrowing of structure from the

nonanalogous jar lid / food packing art. This is a field of endeavor far removed from the manufacture of vehicle license plate covers.

In any event, the pointed-to Dutt structure (the Applicant believes the Examiner meant to point to Dutt's Figures 4 and 5 rather than Figures 3 and 4) are called "flanges" 60 and 62 in Dutt's specification. There is a reason why Dutt did not call them "compression ribs": they don't compress. As best shown in Figure 5, the tips of these flanges 60, 62 are not designed to "compress" against the jar top, but rather to intentionally miss it on the inside and the outside. The flanges 60, 62 define an inverted U-shaped channel or valley between them, such that jar walls of various thicknesses and even having chips and imperfections can still be sealed against the gasket. See Dutt, Col. 5, Lines 14 – 50.

Claim 19, on the other hand, recites at least one elongate compression rib which extends inwardly from the gasket receiving surface *towards* the license plate (and not in some other, intentionally different direction, like Dutt's splayed flanges). Claim 19 necessarily incorporates the limitations of Claim 7, which requires that the receiving surface of the gasket be "generally planar" and face inwardly toward the license plate. There is no such planar receiving surface in the flanged Dutt structure, but rather a nonplanar valley designed to capture a jar sidewall that is smaller in cross-sectional extent than the gasket itself. Applicant's structure, designed to seal against a large flat license plate surface, is patentably distinct in structure and in function from a structure designed to capture a thin cylindrical rim of a food jar in between splayed inner and outer annular flanges.

Nor would it have been obvious to add a compression rib to the Leopold et al. structure, even supposing that Dutt discloses such. The Leopold et al. structure shows a peripheral gasket 10 with a substantially flat or concave inner surface that seals against a convex peripheral license plate

bead 9. Putting a rib on the Leopold et al. gasket would defeat its ability to seal to the convex license plate bead.

For the above reasons and those expressed in relation to Claim 7, on which Claim 19 depends, Claim 19 is patentable over the prior art. Claims 3, 4 and 8 are patentable at least for their dependency on allowable Claims 7 and 19. Further, in regard to Claim 3, the Examiner states that Dutt shows the use of first and second ribs, the outer rib being considered a rim. What Dutt really shows is a structure with two “rims” and no compression ribs at all. As is best shown in Dutt’s Figure 5, Dutt’s flanges are designed to extend beyond the outer and inner sides of the jar lid top, rather than compress against it. Also, Claim 3 recites that an innermost portion of the rim be disposed in a plane inward (toward the license plate) from the compression rib; Dutt’s flanges extend downwardly by the same amount. Claim 3 therefore contains limitations that make it additionally patentable over an attempted combination of Leopold et al., Payson and Dutt.

Relative to Claim 8, the Examiner states that Leopold et al.’s gasket 10 doesn’t completely cover the external glass cover flange 3, and that therefore the portion of the bottom is considered to be open. Applicant has amended Claim 8 to make clear that it is the rib which is discontinuous, at a portion thereof that is adjacent the bottom of the frame periphery. Leopold et al. and Payson disclose continuous circumferential gaskets that do not have compression ribs at all, much less a compression rib with this intentional discontinuity or “weepole”.

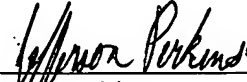
In summary, all of the claims extant in this application patentably define over the prior art. Applicant therefore respectfully solicits the Examiner’s early Notice of Allowance of these claims.

This Reply to Examiner’s Action is being submitted within the three-month shortened statutory period for response, but with a fee for Request for Continued Examination, as set forth in

Attorney Docket No. 301700-00066

the enclosed Fee Transmittal. The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 503138 of Daspin & Aument, LLP.

Respectfully submitted,



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